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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/499,238	02/07/2000	Gregory A. Stobbs		9957

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EXAMINER
WONG, LESLIE

ART UNIT	PAPER NUMBER
2177	

DATE MAILED: 11/14/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

	Application No.	**Applicant(s)**
Office Action Summary	09/499,238	STOBBS ET AL.
	Examiner	**Art Unit**	
	Leslie Wong	2177	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 August 2002* .

2a)☒ This action is **FINAL**.　　2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-32* is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

　　If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☐ All b)☐ Some * c)☐ None of:

　　　　1.☐ Certified copies of the priority documents have been received.

　　　　2.☐ Certified copies of the priority documents have been received in Application No. _____ .

　　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

　　a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)　　　　4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)　　5) ☐ Notice of Informal Patent Application (PTO-152)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .　　6) ☐ Other: .

DETAILED ACTION

Allowable Subject Matter

1.   The indicated allowability of claim 4 is withdrawn in view of the newly discovered

reference(s) to **Snyder et al.** (U.S. Patent 6,038,561). Rejections based on the newly

cited reference(s) follow.

Drawings

2.   Applicants Amendment dated 30 August 2002 mentioned that revised drawings

have been submitted; however, none were found in the application. Applicant is

reminded to resubmit the revised drawings in order to overcome the drawing objection.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act

of 1999 (AIPA) do not apply to the examination of this application as the application

being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily

published under 35 U.S.C. 122(b). Therefore, this application is examined under 35

U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4.   Claims 1, 2, 4-8, 10-12, 14-16, 18-23, 25-32 are rejected under 35 U.S.C. 102(e)

as being anticipated by **Snyder et al.** (U.S. Patent 6,038,561).

Regarding claims 1, 11, and 32, **Snyder et al.** teaches a method and computer

implemented patent portfolio analysis method comprising:

a).   retrieving a corpus of patent information from a database, said information

including the claim text of at least one claim (col. 4, lines 3-7);

b).   analyzing the claim text of said at least one claim to generate a claim

breadth metric corresponding individually to said at least one claim (col. 3, lines 29-31;

col. 17, line 65 – col. 18, line 8);

c).   associating said claim breadth metric with said claim text and storing said

associated metric in a computer-readable dataset (col. 14, lines 36-43 and 60-62).

Regarding claims 2 and 12, **Snyder et al.** further teaches a step of analyzing the

claim text includes counting the number of words in said claim text and generating a

claim breadth metric therefrom (col. 14, lines 36-59).

Regarding claims 4, 14, and 18, **Snyder et al.** further teaches a step of analyzing

the claim text includes parsing said text to identify parts of speech (col. 13, lines 33-34),

using said identified parts of speech to identify clauses within said claim, comparing

said clauses with the text of other claims in said corpus to generate scores indicative of

which clauses within said claim text have a lower probability of being found in other

claims within said corpus (col. 3, lines 50-58; col. 4, lines 8-18; col. 17, line 65 – col. 18, line 17).

Regarding claims 5 and 15, **Snyder et al.** further teaches a step of displaying said patent information in a sorted order based on said claim breadth metric (col. 27, lines 32-36).

Regarding claim 6, **Snyder et al.** further teaches a step of analyzing the claim text includes linguistically processing said text to identify at least one clause within said claim text that has a lower probability than other of said clauses within said claim text of being found in other claims within said corpus (col. 3, lines 29-31; col. 4, lines 49-62; and col. 25, lines 7-25).

Regarding claims 7 and 19, **Snyder et al.** further teaches a step of displaying said claim text such that said one clause is visually presented differently than the other of said clauses (col. 4, lines 12-16).

Regarding claims 8 and 23, **Snyder et al.** further teaches a method-implemented patent portfolio analysis method comprising:

a).   retrieveing a corpus of patent information from a database (col. 4, lines 3-7);

b).   analyzing said patent information to generate a category metric

corresponding to user-prescribed categories (col. 25, line 60 – col. 26, line 5);

c).   associating said category metric with said patent information and storing

said associated metric in a computer-readable dataset (col. 14, lines 36-43 and 60-62).

Regarding claims 10 and 25, **Snyder et al.** further teaches wherein said patent

information includes claim text information to be analyzed and wherein said analyzing

step includes:

a).   defining an eigenspace representing a training population of training

claims each training claim having associated training text (col. 17, line 65 – col. 18,

line4; col. 18, lines 9-17)

b).   representing at least a portion of said training claims in said eigenspace

and associating a predefined category with each training claim in said eigenspace (col.

18, lines 48-58); and

d).   projecting the claim text information to be analyzed into said eigenspace

and associating said projected claim text the predefined category of the training claim to

which it is closest within the eigenspace (Figs. 8A-8C and col. 18, lines 59-61; col. 23,

lines 11-18).

Regarding claim 16, **Snyder et al.** further teaches a step wherein the sorted

patent documents are used in a patent infringement study (col. 4, lines 8-18).

Regarding claim 20, **Snyder et al.** further teaches a step wherein generating descriptive statistics based upon the generated claim breadth metrics, wherein the generated descriptive statistics are indicative of quality of claims analyzed (col. 24, lines 4-20).

Regarding claim 21, **Snyder et al.** further teaches a step wherein generated descriptive statistics are generated for groupings of claims (col. 24, lines 34-39).

Regarding claim 22, **Snyder et al.** further teaches a step wherein the claim groupings are formed based upon patent ownership, wherein the generated descriptive statistics are statistics selected from the group consisting of average, average of the averages, standard deviation, maximum, minimum, and combinations thereof (Fig. 8D).

Regarding claim 26, **Snyder et al.** further teaches a step wherein said patent information includes using both patent classification information and linguistic analysis results to determine said category metrics to be associated with the patent documents (col. 13, lines 44-56).

Regarding claim 27, **Snyder et al.** further teaches a step wherein the category metrics are indicative of technical areas (i.e., input category of interest) of the patent documents (col. 26, lines 28-30).

Regarding claim 28, **Snyder et al.** teaches a step wherein further comprising:

a).   retrieving text of claims from the database, wherein the text of claims are from the plurality of patent documents (col. 25, line 60 – col. 26, line 3);

b).   analyzing the text of the claims in order to generate claim breadth metrics for the claims, wherein a claim breadth metric is indicative of claim breadth of a claim, wherein the claim breadth metrics are used to analyze the claims (col. 25, lines 7-25).

Regarding claim 29, **Snyder et al.** teaches a step wherein values of the category metrics are predetermined (col. 24, lines 29-39).

Regarding claim 30, **Snyder et al.** teaches a step wherein values of the category metrics are dynamically determined (col. 23, 18-29).

Regarding claim 31, **Snyder et al.** further teaches a computer-implemented patent portfolio analysis apparatus comprising:

a).   a database of patent documents containing text of claims (col. 4, lines 3-7);

b).   a claim breadth analysis module that analyzes the text of the claims in order to generate claim breadth metrics for the claims, wherein a claim breadth metric is indicative of claim breadth of a claim (col. 25, lines 7-25), wherein the claim breadth metrics are provided over an internet network for use in analyzing scope of the claims (col. 25, lines 40-5);

c). a cluster generator that analyzes patent information to generate category metrics for the patent documents, wherein clusters of patent documents are determined based upon the generated category metrics (col. 23, lines 10-41 and col. 24, lines 49-62), wherein the clusters of patent documents are provided over an internet network for use in analyzing the patent documents (col. 25, lines 40-58).

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6.   Claims 3 and 13 rejected under 35 U.S.C. 103(a) as being unpatentable over **Snyder et al.** (U.S. Patent 6,038,561).

Regarding claims 3 and 13, **Snyder et al.** does not explicitly teaches a step wherein said step of analyzing the claim text includes identifying within said claim text a preamble portion and a body portion, counting the number of words in said preamble and body portions and applying separate weights to said count to generate said claim breadth metric.

It should be noticed that although **Snyder et al.** does not explicitly teaches the above step, such practice is well-known in the field of Patent claim drafting. In this present case, the ordinary skill in the art would have known that the breadth of a claim is inversely proportional to the quantity of limitations recited therein.

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

8.   Claims 9, 17 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable

over **Snyder et al.** (U.S. Patent 6,038,561) as applied to claims 1-8, 10-16, 18-23, 25-

32 above and in view of **Rivette et al.** (U.S. Patent 6,339,767 B1).

Regarding claim 17, **Snyder et al.** does not teach a step wherein the sorted

patent documents are used to determine patent documents whose maintenance fees

are not to be paid.

Rivette et al., however, teaches a step wherein the Financial Modules perform

patent-centric and group-oriented processing of the data in the financial database.

Examples of the functions performed by the financial modules include determining the

research and design expenditures, determining maintenance fees, and determining

cumulative product revenue on a product or product line basis, etc. (col. 94, lines 23-

43).

It would have been obvious to one of ordinary skill in the art at the time of the

invention was made to employ the Financial Modules as taught by **Rivette et al.** in

order to project various types of costs on certain products or licensing revenue

associated with any patent own by the company (col. 94, lines 62-64).

Regarding claims 9 and 24, **Snyder et al.** does not explicitly teach a step

wherein said analyzing step is performed by defining a plurality of categories and

mapping classification information onto said categories.

Rivette et al., however, teaches a step wherein said analyzing step is performed

by defining a plurality of categories and mapping classification information onto said

categories (Figs. 84 and 85).

It would have been obvious to one of ordinary skill in the art at the time of the

invention was made to incorporate mapping categories to classification information as

taught by **Rivette et al.** because this would clearly identify classifications that the

category belong to in order to fine tune and directly search those classes.

Response to Argument

9.   Applicant's arguments with respect to claims 1-32 have been considered but are

moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Leslie Wong whose telephone number is (703) 305-

3018. The examiner can normally be reached on Monday to Friday 9:30am - 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

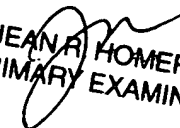supervisor, John E Breene can be reached on (703) 305-9790. The fax phone numbers

for the organization where this application or proceeding is assigned are (703) 746-7239

for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist whose telephone number is (703) 305-

3900.

Leslie Wong
Patent Examiner
Art Unit 2177

lw
November 11, 2002

JEAN R HOMERE
PRIMARY EXAMINER